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IN THE

Supreme Court of the United States

OCTOBER TERM, 1945.

No. [redacted] 24

HALLIBURTON OIL WELL CEMENTING COMPANY, a Delaware Corporation,

Petitioner,

vs.

CRANFORD P. WALKER and CRANFORD P. WALKER, ROBERT P. MILLER and MILO C. KETCHUM, doing business as DEPTHOGRAPH COMPANY, a copartnership,

Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

This case is but an ordinary patent infringement suit wherein the defendant Halliburton Oil Well Cementing Company has been and is now making and using instruments for the surveying of oil wells to determine the height of the column of fluid in an oil well bore as a service for pay to various oil companies, such instruments embodying plaintiffs' patented inventions and plaintiffs brought this suit for infringement.

The District Court, after hearing and receiving the evidence, held that plaintiffs' patent No. 2,156,519 was valid and infringed as to the claims in issue and entered appropriate findings of fact and conclusions of law. [R. 27-32.]

Defendant appealed to the Circuit Court of Appeals for the Ninth Circuit, which Court after hearing affirmed the decision of the District Court as to both infringement and validity. [R. 1594-1604.]

Defendant thereupon petitioned the Circuit Court of Appeals for the Ninth Circuit for rehearing, setting forth in detail the two questions which it now presents to this Court upon its petition for a Writ of Certiorari. To this petition, respondents filed a reply.

Upon a full consideration of the petition for rehearing and the grounds set forth, the Ninth Circuit Court of Appeals entered an order directing filing of opinions on petition for rehearing and denying petition. [R. 1613-1616.]

There is no conflict of decision with respect to plaintiffs' patent between two Circuit Courts of Appeals, nor does this case involve any principle, the settlement of which is of importance to the public interest.

Apparently the defendant, having presented both in the District Court and in the Circuit Court of Appeals for the Ninth Circuit, its best arguments, its best defenses and its best theories, to be met only with failure, now seeks to have this Court review the same arguments, defenses and theories in the hope that this Court will disagree with the District Court and the Circuit Court of Appeals.

It is contended therefore by respondents that defendant presents no case to this Court which would warrant the grant of a Writ of Certiorari.

Petitioner urges that despite the fact that there is no conflict of decision in the several Circuit Courts with respect to plaintiffs' patent, an exception should be made in this case to the general rule of this Court as announced in *Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U. S. 387; *Keller v. Adams Campbell Co.*, 264 U. S. 314; *General Talking Pictures v. Western Electric Co., Inc.*, 304 U. S. 175, for the purported reasons:

(1) That petitioner feels that the ruling of the Circuit Court of Appeals for the Ninth Circuit is in conflict with the decision of this Court in *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364;

(2) That petitioner feels that a question of great public importance has been raised but not decided by petitioner's fantastic theory that because the Patent Office held that plaintiffs' patentee was not entitled to a second patent covering only a mechanical equivalent of the subject matter disclosed and claimed in the patent in suit, then the claims of the patent in suit should be construed so narrowly as not to include what the Patent Office held to be a mechanical equivalent within the scope of the claims of the patent in suit; and

(3) That plaintiffs fear that because no other suits have been started in other circuits on plaintiffs' patent, conflict between Circuit Courts of Appeals is improbable.

In the following, the foregoing grounds will be discussed in the order presented:

Petitioner's Ground 1.

As to petitioner's first ground, petitioner is seeking a ruling by this Court that in a claim for a combination of elements cooperating together to perform a single new and useful result the patentee must recite every element of the combination in specific and limited terms whereas it is fundamental patent law that where a patentee is the first to combine together a new combination of elements or pieces of apparatus to achieve a new result he is entitled to broad claims upon that combination of elements and may recite the elements as broadly as the prior art will permit.

In presenting its theory petitioner seeks to broaden the ruling of this Court in *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, to cover a situation which was not present in that case.

In the *General Electric Co. v. Wabash Appliance Corp.* case the question presented to this Court was that of determining whether or not a claim to an article of manufacture constituting a single element was sufficiently definite to teach the art how to practice that invention when the language of the claim was so vague as to fail to act as a guide to those who might desire to practice the patented invention. This Court justly held that the patentee in that case had not complied with the requirement of the Patent Statutes to specifically point out the novelty sought to be covered by the patent.

In the instant case the situation is entirely different in that the patentee in the patent in suit discloses for the

first time the combination of three elements excellently set forth and discussed by Judge Denman in his concurring opinion on the denial of the petition for rehearing by the Circuit Court of Appeals for the Ninth Circuit as elements "A," "B" and "C." [R. 1614-1616.]

In the instant case, although the prior art may have shown the combination of elements B and C (and for the purposes of this argument it may be assumed that the prior art did show the combination of those two elements), the prior art did not show the combination therewith of the third element D.

Petitioner bases its entire theory as to the first ground of this petition upon the assertion that the expression "means," followed by a statement of the function such means is to perform in the combination, is fatally indefinite. That this theory is incorrect is obvious when the particular invention under consideration is analyzed.

The patentee Walker discovered that by adding element D into the combination with elements B and C a useful and successful device could be made which would accomplish the result which the prior art had sought to accomplish but had failed to achieve.

If petitioner's theory is adopted, then any patentee in attempting to claim a combination of elements or pieces of apparatus would be required to recite each of the elements in specific detail and the claim which would be awarded to him could be construed only to cover specifically the one embodiment of the invention which he il-

lustrates and describes in detail in the specification of his patent.

That this was not the intent of this Court in its decision in the *General Electric Co. v. Wabash Appliance Corp.* case is obvious from a reading of the opinion in that case and it is further obvious that this Court had no intention of denying reasonably broad scope to the claims of a patent which defines not only the difference between success and failure but a real and material advance in the art.

It is submitted that the carefully considered and carefully worded opinions of the Circuit Court of Appeals for the Ninth Circuit, both the original opinion written by Judge Healy and the opinion on the petition for rehearing written by Judge Healy, as well as the concurring opinion written by Judge Denman, demonstrate that the Circuit Court of Appeals for the Ninth Circuit was not only fully cognizant of the import of the ruling of this Court in the *General Electric Co. v. Wabash Appliance Corp.* case but distinguished the facts of the instant case from those of the *General Electric Co. v. Wabash Appliance Corp.* case in accordance with established principles of patent law.

In the instant case the facts presented are identical with those considered by Judge Hand in *Buono, et al. v. Yankee Maid Dress Corporation*, 77 F. (2d) 274, 277, in which the Court stated:

> "The only debatable matter is of the language of the claims themselves; it is the old question of how

far a claim may safely be cast in terms of function. * * * The other elements of claim 6 except a single one are in mechanical terms referable to the disclosure, and are clearly not functional. The exception is, 'operating means connected to said eccentric device and turning said pivoted device at predetermined intervals.' This too is readily enough identified by the disclosure, and though it does speak in terms of function that is inevitable to some degree, if the claim is to have any generality whatever. The very test of equivalency is in terms of function, 'the same result by the same means'; *and it is only by recourse to that standard that a patentee can pass beyond the very details of his disclosure.* Some such latitude being necessary, it is only a question of how far the functional element is anchored in the disclosure, and how far it floats as a vague threat to the art. That is a question of degree, and admits of no general solution, for the mere use of the word 'means' does not condemn a claim. Tokheim Oil Tank & Pump Co. v. Dean, 73 F. (2d) 32, 35, 36 (C. C. A. 7); Heidbrink v. McKesson, 290 F. 665, 668 (C. C. A. 6). In the case at bar the phrase was justified because the invention did not reside in the mechanical train connecting the eccentric with the table, but in a train which should tilt it at intervals longer than the oscillations of the rib. The details not being important, the general notion so embodied the inventors might protect." (Emphasis added.)

Therefore, as to Ground 1, petitioner has presented no valid reason for the grant of a Writ of Certiorari.

Petitioner's Ground 2.

To properly expose the fallacy of the theory upon which petitioner bases its second ground for its petition, it is only necessary to point out that the patent in suit was the first patent in the art to which it relates to disclose the combination of the three elements set forth by Judge Denman in his opinion. [R. 1614-1616.] To illustrate and specifically describe one embodiment of the invention, the patentee illustrated and described a "mechanical" structure in the sense that the structures illustrated and described were not electrical devices. The claims which were presented in the patent in suit and which were allowed and which are the claims in suit were couched in broad language sufficient to include both the specific mechanical devices illustrated and described in the patent and "equivalents" thereof. Subsequent to the filing of the application for the patent in suit, the patentee filed a second application in which the specific embodiment of the invention is illustrated and described as including electrical devices.

Upon examination of the second application, the Patent Office, then having access to the patentee's prior patent (the patent in suit), cited the patent in suit and rejected claims to the electrical version of the device *upon the ground that the electrical apparatus disclosed in the second application was only the mechanical equivalent of the invention upon which the patentee had already been given a patent and which was included in the scope of the*

claims which had been granted in the earlier patent (the patent in suit).

Petitioner seeks to distort the ruling of this Court in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211, to reach the absurd conclusion that a pioneer patentee, having obtained a broad claim upon an invention, one embodiment of which is illustrated and described in the patent, dares not file subsequent applications upon what he may consider are improvements over the specific disclosure in the first patent for fear that a rejection of the claims in the improvement patent will require the courts to limit the claims of his first patent to the specific embodiment of the invention illustrated and described therein and would prevent the construction of the claims in the first patent broadly enough to cover what the Patent Office might hold to be a mechanical equivalent thereof disclosed in the second application for patent.

The facts of the *Schriber-Schroth Co. v. Cleveland Trust Co.* case were that in a single patent application the patentee presented claims to a part of his invention and upon rejection canceled those claims *in order that that patent could issue*, and then the patentee sought at a later date to have others of the claims obtained in that patent so broadly construed as to cover the very subject matter which he canceled in order to obtain his patent.

In effect, in the *Schriber-Schroth* case the Court was presented with a contract, during the negotiations for which (the proceedings in the Patent Office) attempt was made to include material and upon rejection such mate-

rial was canceled in order that the contract might be completed. Then at a later date the patentee seeks to alter the terms of that contract to include the material he once sought to have in that contract but subsequently deliberately canceled therefrom.

In the instant case the patentee applied for and obtained a pioneer patent upon the combination and, in so doing, carefully drafted the claims so as to include not only the specific mechanical embodiment of his invention but "equivalents thereof." In a later attempt to obtain a second patent upon electrical apparatus for accomplishing the same result, the Patent Office held that the broad *electrical claims* defined only the mechanical equivalent of the subject matter upon which the patentee had already been granted broad claims capable of covering the electrical apparatus.

To adopt petitioner's theory would greatly injure the progress of science and the arts since once a patentee had disclosed one embodiment of his invention and obtained a patent thereon he would be discouraged from daring to disclose other embodiments and improvements for fear that by so doing he would destroy the protection he had already been granted.

This fallacious theory was advanced by petitioner to the Circuit Court of Appeals for the Ninth Circuit and the absurdity of the theory was undoubtedly the reason the Circuit Court did not even deign to refer to it in its opinion on the petition for rehearing.

The facts in the instant case are clearly distinguishable from the *Schriber-Schroth Co. v. Cleveland Trust Co.* case and are so admitted to be by petitioner on page 13 of its petition to this Court, wherein it is stated:

> "In many other cases, this Court has applied the doctrine of file wrapper estoppel, but we have been able to find no case in which the facts are exactly the same as those in the case at bar.
>
> "Walker could have filed one application for patent covering the two systems he had conceived. Instead, he filed two applications, one on the mechanical system and one on the electrical. Had both ideas been presented in one application and those on the electrical system been rejected on the prior art and cancelled, the facts would be the same as in the above cited cases."

What petitioner fails to say is that in the instant case *there was no prior art upon which the electrical claims could be rejected* except Walker's own patent in suit.

It is therefore submitted that, as to Ground 2, no principle of patent law is presented in this case which would warrant the grant of a Writ of Certiorari by this Court.

Petitioner's Ground 3.

In support of its Ground 3, petitioner urges that petitioner and respondents are the only concerns furnishing sonic depth measuring apparatus to owners and operators of oil wells and that for this reason conflict between the Circuit Courts as to the patent in suit is improbable.

Petitioner refutes its own argument by pointing out that, in addition to petitioner and respondents, at least one other company, the Gulf Oil Company, has made and used a device of the character involved in this litigation and hence constitutes another competitor against which suit will probably be brought under the patent in suit in another circuit.

It is submitted that the mere fact that respondents have not as yet instituted other suits in other circuits is not sufficient ground for this Court making an exception in this case to its general rule of refusing to grant a Writ of Certiorari where no conflict of opinion exists.

Respectfully submitted,

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Los Angeles, California,
August 21, 1945.